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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,930	12/18/2001	William S. Lerner		2542

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EXAMINER

CASTELLANO, STEPHEN J

ART UNIT	PAPER NUMBER
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3727

12

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,930

Applicant(s)

LERNER, WILLIAM S.

Examiner

Stephen J. Castellano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-30 and 32-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 25-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant has withdraw claims 1-12 from consideration.

Newly submitted claim 31 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 31 is withdrawn as it pertains to a specie that was not presented with the original claims. This specie pertains to the configuration shown in Fig. 6. Claim 31 is withdrawn from consideration by original presentation.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 31 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 13-30 and 32-37 remain for treatment on their merits.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-25, 27, 29, 30, 33 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites the limitation "the disk" in the second to last line. There is insufficient antecedent basis for this limitation in the claim because it states the disk resting on the bottom of the plastic food container and it is not clear whether the first mentioned disk or the second disk is meant. The first mentioned disk might not rest on the bottom while another portion of the first insert rests on the bottom. Even though the second insert rests on the intermediate portion of the

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sloping container wall, the second disk might rest on the bottom since nothing precludes the second disk from resting on the bottom.

Claim 21 recites the limitation "said disk" in the second to last line. There is insufficient antecedent basis for this limitation in the claim because it can't be determined if the first mentioned disk or the second disk is meant.

Claims 22-24 all recite the limitation "the disk." There is insufficient antecedent basis for this limitation in the claim because it can't be determined if the first mentioned disk or the second disk is meant.

Claims 25, 27, 29, 33 and 36 contain the trademark/trade name TUPPERWARE, GLAD, and ZIPLOCK. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe plastic food containers and, accordingly, the identification/description is indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 13-15, 17-19, 25, 27, 32 and 33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Simko, Clark, Peterson, McGinnis and Gordon et al. (Gordon).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15, 17-19, 25, 27, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heverly, Telkes, Conklin and Bair et al. (Bair) in view of McGraw, Simko and Peterson.

Heverly discloses a combination of a thermal preservation insert (gel pack 30) and a plastic food container (outer pan 20). Telkes discloses a combination of a thermal preservation insert (lower grid 14) and a plastic food container (container 10 and insulated packing materials which include plastic foam, see column 2, lines 42-44). Conklin discloses a combination of a thermal preservation insert (gel pack 29) and a plastic food container (frame 23 and bottom wall 25 of the cover 15). Bair discloses a combination of a thermal preservation insert (shelf member 18) and a plastic food container (receptacle 11).

Re claim 17, Heverly, Telkes, Conklin and Bair all have a sloping container wall and the sloping container wall narrowing toward the bottom.

Heverly, Telkes, Conklin and Bair disclose the invention except for the thermal preservation insert being circular in shape as the disk is circular. McGraw, Simko and Peterson teach circular food containers holding circular food containers and circular disks with refrigerant within their internal cavities. It would have been obvious to modify the shape of the food

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containers to be circular to conform to the shape of a circular article being cooled as such conformity eliminates wasted cooled space. It would have been further obvious to modify the shape of the inserts to be circular to conform the inserts to the modified form of the containers to maximize the cooling of the insert without making the insert larger than the inner periphery of the container so that the insert fits.

Re claims 25 and 27, the plastic food container is of a size and shape sold under the brand names because the brand name doesn't restrict the size and shape. The owner or licensee of the brand may alter the size and shape as desired.

Claims 17-19 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simko, Clark, Peterson, McGinnis and Gordon in view of McGraw.

Simko, Clark, Peterson, McGinnis and Gordon disclose the invention except for the sloping container wall doesn't narrow toward the bottom. McGraw teaches the narrowing toward the bottom. It would have been obvious to narrow towards the bottom in order to provide nesting and compact storage of a series of nested containers.

Claims 21-23, 26, 28-30, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over [Simko, Clark, Peterson, McGinnis and Gordon in view of McGraw] and [Heverly, Telkes, Conklin and Bair et al. (Bair) in view of McGraw, Simko and Peterson] in view of Loucks and Loofburrow et al. (Loofburrow).

The combinations of [Simko, Clark, Peterson, McGinnis and Gordon in view of McGraw] and [Heverly, Telkes, Conklin and Bair et al. (Bair) in view of McGraw, Simko and Peterson] disclose the invention except for the stack of two disks. Loucks teaches stacked coolant containers (27) and Loofburrow teaches stacked coolant containers (10). It would have

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been obvious to add another disk to double the cooling effect in the plastic food container to provide both a cooler temperature and to lengthen the time of cooling.

Claims 16, 20 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over [Simko, Clark, Peterson, McGinnis and Gordon in view of McGraw] and [Heverly, Telkes, Conklin and Bair et al. (Bair) in view of McGraw, Simko and Peterson] in view of Cummings.

The combinations of [Simko, Clark, Peterson, McGinnis and Gordon in view of McGraw] and [Heverly, Telkes, Conklin and Bair et al. (Bair) in view of McGraw, Simko and Peterson] disclose the invention except for the tab. Cumming teaches an upper plastic surface having a plastic tab (16) jutting out. It would have been obvious to add the plastic tab to provide a finger grip for easier removal.

Claims 24 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over [Simko, Clark, Peterson, McGinnis and Gordon in view of McGraw] and [Heverly, Telkes, Conklin and Bair et al. (Bair) in view of McGraw, Simko and Peterson] in view of Cummings, Loucks and Loofburrow.

The combinations of [Simko, Clark, Peterson, McGinnis and Gordon in view of McGraw] and [Heverly, Telkes, Conklin and Bair et al. (Bair) in view of McGraw, Simko and Peterson] disclose the invention except for the tab and the stack of two disks. Cumming teaches an upper plastic surface having a plastic tab (16) jutting out. It would have been obvious to add the plastic tab to provide a finger grip for easier removal. Loucks teaches stacked coolant containers (27) and Loofburrow teaches stacked coolant containers (10). It would have been obvious to add another disk to double the cooling effect in the plastic food container to provide both a cooler temperature and to lengthen the time of cooling.

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Applicant's arguments with respect to claims 13-37 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Castellano whose telephone number is 703-308-1035. The examiner can normally be reached on M-Th 6:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W. Young can be reached on 703-308-2572. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Stephen J. Castellano
Primary Examiner
Art Unit 3727

sjc